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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

RAGONESE, ANDREA M

ART UNIT PAPER NUMBER

3743

DATE MAILED: 01/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/749,142

Applicant(s)STOCKMAN-LAMB, MELISSA
SOYNA**Examiner**

Andrea M. Ragonese

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☒ Claim(s) 1-12 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 July 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Drawings

1. New corrected drawings in compliance with 37 CFR 1.121(d) are required in this application because the informal drawings are not of sufficient quality to permit proper examination of the instant invention.
2. Applicant is advised to employ the services of a competent patent draftsman outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.
3. Accordingly, replacement drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to this Office action. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action.

Specification

4. The use of the trademark ADVAIR® has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.
5. Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner, which might adversely affect their validity as trademarks.

Claim Objections

6. **Claims 1-12** are objected to because the claims are generally narrative and indefinite, failing to conform with current U.S. practice. They are replete with grammatical and idiomatic errors. Appropriate correction is required.

7. The following list of informalities contains some few examples (along with suggested corrections), and is not intended to encompass each and every discrepancy with claim format:

- in **claim 1**, “comprising of:” should be deleted and – comprising: – inserted therefor;
- in **claim 1**, “A cap” should be deleted and – a cap – inserted therefor;
- in **claim 3**, “indicated when a inhaler” should be deleted and – indicates when an inhaler – inserted therefor; and
- in **claim 11**, “having” should be deleted and – further comprising – inserted therefor, and “medicine” should be deleted and – medicine. – inserted therefor.

Claim Rejections - 35 USC § 112

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. **Claim 6** is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention since it is not in proper dependent claim form.

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10. Any rejections in this Office action have been made by applying any pertinent prior art in the field to the merits of the claimed invention as best understood by the Examiner.

Claim Rejections - 35 USC § 102

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

12. **Claims 1-5 and 7-12** are rejected under 35 U.S.C. 102(b) as being anticipated by Jewett et al. (US 5,544,647).

Regarding **claim 1**, Jewett et al. discloses an apparatus comprising a cap **27** having a top and a bottom having hollow center; a sliding mechanism, broadly and reasonably interpreted by the Examiner to be the sleeve **12** since sleeve **12** allows the cap **27** to move up and down when manually depressed by a patient operating the apparatus; a battery **32** operated digital counter screen **54** attached to the sliding mechanism; and securing arms, broadly and reasonably interpreted by the Examiner to be the right and left sides of enclosure **30** since enclosure **30** extends outwardly from screen **54**, around sleeve **12**.

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Regarding **claim 2**, wherein said counter **54** is progressed manually when the canister **16** is depressed by the patient.

Regarding **claim 3**, wherein said apparatus is fully capable of indicating when an inhaler **10** is almost empty.

Regarding **claim 4**, where said securing arms **30** extend outward over an inhaler **10** and said apparatus is fully capable of keeping track of how many doses of said inhaler **10** are used.

Regarding **claim 5**, wherein said apparatus is used with an inhaler **10** with a metal canister **16**.

Regarding **claim 7**, wherein said apparatus is depressed causing a metal canister **16** to also be depressed into an actuator to dispense an inhalation medicine.

Regarding **claim 8**, wherein said apparatus is fully capable of monitoring frequency, time intervals and amount of medication dispensed or used.

Regarding **claim 9**, wherein said apparatus is reusable.

Regarding **claim 10**, wherein said apparatus is interchangeable.

Regarding **claim 11**, where said apparatus has an alarm **38** which is fully capable of being programmed to alert patients when to take medicine.

Regarding **claim 12**, wherein said apparatus is fully capable of being used with an actuator for any type of aerosol medication.

13. **Claim 6** is rejected under 35 U.S.C. 102(e) as being anticipated by Brand et al. (US 2003/0183226 A1). Brand et al. discloses an apparatus comprising a counter **12** that is solar powered.


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Conclusion

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Andrea M. Ragonese whose telephone number is 571-272-4804**. The examiner can normally be reached on Monday through Friday from 9:00 am until 5:00 pm.

15. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Henry A. Bennett can be reached on 571-272-4791. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

16. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AMR 
January 9, 2005


Henry A. Bennett
Supervisor Patent Examiner
Group 3700